

### **REMARKS/AGRUMENTS**

Reconsideration of this application as amended is respectfully requested.

The Examiner has rejected claim 20 under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling.

The Examiner has rejected claims 2, 5, and 7 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner has rejected claims 1-4, 7-10, 13-16, 19-24, and 27-29 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,304,900 to Cromer, et al. (hereafter "Cromer") in view of applicants' alleged prior art. (hereafter "the alleged prior art").

The Examiner has rejected claims 5-6, 11-12, 17-18, and 25-26 under 35 U.S.C. §103(a) as being unpatentable over Cromer in view of the alleged prior art in further view of U.S. Patent No. 6,539,432 to Taguchi, et al. (hereafter, "Taguchi").

### **CLAIM REJECTIONS – 35 USC §112¶1**

The Examiner has rejected claim 20 under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling. The Examiner states in part that:

"A purpose of using the specified types of ports, critical or essential to the practice of the invention, but not included in the claim is not enabled by the disclosure. See *In re Mayhew*..."

(Office Action, 7/9/03, p. 2)

Applicants respectfully disagree with the Examiner's analysis of *In re Mayhew* as well as his rejection. Claim 20 recites "The network interface of claim 19, wherein the one or more ports are OC ports, STS ports or SDH ports." Adequate disclosure of claim 20 exists in the specification in numerous places, for example the paragraph beginning on page 6, line 19, and ending on page 7, line 4. Furthermore, *In re Mayhew* discusses rejections when a feature which

is taught as critical in the specification is not recited in the claims. (*see MPEP §2164.08(c), MPEP §2172.01, and MPEP §2174*) The Examiner has failed to point out which feature is taught as critical in the specification. Thus, for the forgoing reasons applicants respectfully submit that claim 20 is enabled and should not be rejected under 35 U.S.C. §112¶1.

**CLAIM REJECTIONS – 35 USC §112¶2**

The Examiner has rejected claims 2, 5, and 7 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2, 5, and 7 have been amended, and applicants respectfully submit that the Examiner's rejections have been overcome.

**CLAIM REJECTIONS – 35 USC §103 (a)**

The Examiner has rejected claims 1-4, 7-10, 13-16, 19-24, and 27-29 under 35 U.S.C. §103(a) as being unpatentable over Cromer in view of the alleged prior art. In regard to the rejection of claim 1 under 35 U.S.C. §103(a), the Examiner has stated in part that:

Cromer does not explicitly implement its counting concept to count for connections.... Therefore it would have been obvious for one of ordinary skill in the art at the time of applicants' invention to modify the system, capable of counting and collecting statistics as taught by Cromer, to count other network events as well, such as conventions.'

(7/9/03 Office Action, p. 4).

Applicant respectfully disagrees. Applicant submits that claims 1-4, 7-10, 13-16, 19-24, and 27-29 are not obvious in view of Cromer and the alleged prior art. It is respectfully submitted that it would be impermissible hindsight, based on applicant's own disclosure, to combine Cromer and the alleged prior art.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation

to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

However, nowhere is there any indication that the references provide any motivation for the recited combination. Instead, it appears the teachings of the present application have been used as a blueprint to gather together and assemble various components of the prior art in the manner contemplated by applicant. This is a classic example of the use of hindsight reconstruction, and cannot properly be used as grounds for rejecting the present claims.

The U.S. Court of Appeals for the Federal Circuit has strongly criticized such applications of hindsight by specifically indicating that when an obviousness determination is made based upon a combination of references, even a patent examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (Emphasis added). Merely indicating, as the Examiner argues in his Office Action of July 9, 2003, that the claimed invention would be obvious to one of ordinary skill in the art based on the combination of the references is utterly inadequate. *Rouffet*, at 1357. Instead, what is needed is a showing of motivation, either from the references themselves or the knowledge of those of ordinary skill in the art, for the combination being relied upon. *Rouffet*, at 1357.

In the present case, there has been no showing of such motivation. Instead, the Examiner attempts to deconstruct the subject matter of the claims of the present application into its constituent components, states where each such component may be found in one of the cited references, and then concludes that it would have been obvious to combine the references to arrive at the claimed invention. This bare bones analysis is not sufficient to support a determination of obviousness of the present application. The burden is on the Examiner to show *why* one is so motivated as to come up with the combination being relied upon. *Rouffet*, at 1357-1358 ("If such a rote invocation could suffice to supply a motivation to combine, the more

sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields [an infringer or the Patent Office] could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for [obviousness]. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.")

Furthermore, Cromer and the alleged prior art do not suggest combination with one another. Cromer, describes a data processing system and method for permitting a server computer system to modify operation of a client system's network hardware. (Cromer, title). More specifically, Cromer describes a client computer having a plurality of counters and timers and threshold values for each counter and timer. (Cromer, col. 7, ll. 51-55). The alleged prior art describes a network switch, not a client computer. Thus, there is no motivation to combine Cromer with the alleged prior art.

In regard to the rejection of claim 1, even if Cromer and the alleged prior art were combined, such a combination would lack one or more features of claim 1. Claim 1 recites the feature of "... collecting statistics for the connections of the switch having the count value above the threshold before connections having the count value below the threshold." (Emphasis added) This feature is not disclosed by Cromer. Infact, Cromer's invention focuses on client computer systems. More specifically, Cromer uses a plurality of counters and timers within a client computer and threshold values for each counter and timer. (Cromer, col. 7, ll. 51-54). Nowhere does Cromer describe collecting statistics for the connections of the switch... before connections having the count value below the threshold, as claimed by applicants in claim 1. Nor does the alleged prior art disclose this feature.

Thus, because neither, Cromer nor the alleged prior art disclose applicants' claim 1, applicants respectfully submit that claim 1 is not obvious under 35 U.S.C. §103(a) by Cromer in

view of the alleged prior art. Given that claims 2-6 depend from claim 1, applicants respectfully submit that claims 1-6 are not obvious under 35 U.S.C. §103(a).

The Examiner also rejected claim 7 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claim 1. Claim 7 discloses substantially similar limitations as claim 1 and recites “a processor to ...collect the statistics for the connections of the switch... before counters having a count value below the threshold.” Because Cromer, in view of the alleged prior art, does not disclose this feature and given that claims 8-12 depend from claim 7, applicants respectfully submit that claims 7-12 are not obvious under 35 U.S.C. §103(a) by Cromer, in view of the alleged prior art.

The Examiner also rejected claim 13 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claim 1. Claim 13 discloses substantially similar limitations as claim 1 and recites “a processor...to collect the statistics for the connections of the switch...before collecting statistics in the memory derived from counters having a court value below the threshold.” Because Cromer, in view of the alleged prior art, does not disclose this feature and given that claims 14-20 depend from claim 13, applicants respectfully submit that claims 13-20 are not obvious under 35 U.S.C. §103(a) by Cromer, in view of the alleged prior art.

The Examiner also rejected claim 21 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claim 1. Claim 21 discloses substantially similar limitations as claim 1 and recites “means for collecting the statistics for the connections of the switch...before connections having the count value below the threshold.” Because Cromer, in view of the alleged prior art, does not disclose this feature and given that claims 22-26 depend from claim 21, applicant respectfully submits that claims 21-26 are not obvious under 35 U.S.C. §103(a) by Cromer, in view of the alleged prior art.

The Examiner also rejected claim 27 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claim 1. Claim 27 discloses substantially similar limitations as claim 1 and recites "a CPU...to collect the statistics for the connections of the switch...before collecting statistics...having the count value below the threshold." Because Cromer, in view of the alleged prior art, does not disclose this feature and given that claims 28-29 depend from claim 27, applicant respectfully submits that claims 27-29 are not obvious under 35 U.S.C. §103(a) by Cromer, in view of the alleged prior art.

The Examiner has rejected claims 5, 6, 11, 12, 17, 18, 25 and 26 under 35 U.S.C. §103(a) as being unpatentable over Cromer in view of the alleged prior art and further in view of Taguchi. In regard to the rejection of claim 5 under 35 U.S.C. §103(a), the Examiner has stated in part that:

Taguchi teaches the use of logical connection identifiers to "set a logical connection specifying at least one of a source and destination between an ingress and an egress of a connection.  
(7/9/03 Office Action, p. 7).

Applicant respectfully disagrees. Applicant submits that claims 5-6, 11-12, 17-18, and 25-26 are not obvious in view of Cromer, Taguchi and the alleged prior art. It is respectfully submitted that it would be impermissible hindsight, based on applicant's own disclosure, to combine Cromer, Taguchi and the alleged prior art.

Cromer and the alleged prior art do not suggest combination with one another. Cromer, describes a data processing system and method for permitting a server computer system to modify operation of a client system's network hardware. (Cromer, title). More specifically, Cromer describes a client computer having a plurality of counters and timers and threshold values for each counter and timer. (Cromer, col. 7, ll. 51-55). The alleged prior art describes a network switch, not a client computer. Furthermore, Taguchi is not combinable with Cromer for the same reason. Taguchi discusses a specialized network manager that is connected to network

switches. (Taguchi, col. 3, ll. 63-66) Thus, there is no motivation to combine Cromer with Taguchi and the alleged prior art.

In regard to the rejection of claims 5-6, even if Cromer, Taguchi and the alleged prior art were combined, such a combination would lack one or more features of claim 1 from which claims 5-6 depend. Claim 1 recites the feature of "... collecting statistics for the connections of the switch having the count value above the threshold before connections having the count value below the threshold." (Emphasis added) This feature is neither disclosed by Cromer nor the alleged prior art, as described above. Nor does Taguchi disclose this feature as claimed by applicants. Taguchi describes a network manager connected to a plurality of relay nodes (switches and routers) and edge nodes. (Taguchi, col. 3, ll. 56-62). More specifically, Taguchi focuses on quality of service parameter conversion using a network manager. (Taguchi, col. 2, ll. 24-38). Nowhere does Taguchi even discuss collecting statistics. Consequently, Taguchi does not teach ... collecting statistics for the connections of the switch having the count value above the threshold before connections having the count value below the threshold, as claimed by the applicants.

Thus, because neither, Cromer, Taguchi, nor the alleged prior art disclose applicants' claim 1, applicants respectfully submit that claim 1 is not obvious under 35 U.S.C. §103(a) by Cromer and Taguchi in view of the alleged prior art. Given that claim 5-6 depend from claim 1, applicants respectfully submit that claims 1-6 are not obvious under 35 U.S.C. §103(a).

The Examiner also rejected claims 11-12 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claims 5-6. Claim 7, from which claims 11-12 depend, disclose substantially similar limitations as claim 1 and recites "a processor to ...collect the statistics for the connections of the switch... before counters having a count value below the threshold." Because Cromer and Taguchi, in view of the alleged prior art, does not disclose this feature and

given that claims 8-12 depend from claim 7, applicants respectfully submit that claims 7-12 are not obvious under 35 U.S.C. §103(a) by Cromer and Taguchi, in view of the alleged prior art.

The Examiner also rejected claims 17-18 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claims 5-6. Claim 13, from which claims 17-18 depend, discloses substantially similar limitations as claim 1 and recites “a processor...to collect the statistics for the connections of the switch...before collecting statistics in the memory derived from counters having a count value below the threshold.” Because Cromer and Taguchi, in view of the alleged prior art, does not disclose this feature and given that claims 14-20 depend from claim 13, applicants respectfully submit that claims 13-20 are not obvious under 35 U.S.C. §103(a) by Cromer and Taguchi, in view of the alleged prior art.

The Examiner also rejected claims 25-26 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claims 5-6. Claim 21, from which claims 25-26 depend, discloses substantially similar limitations as claim 1 and recites “means for collecting the statistics for the connections of the switch...before connections having the count value below the threshold.” Because Cromer and Taguchi, in view of the alleged prior art, does not disclose this feature and given that claims 22-26 depend from claim 21, applicant respectfully submits that claims 21-26 are not obvious under 35 U.S.C. §103(a) by Cromer and Taguchi, in view of the alleged prior art.



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If there are any additional charges, please charge them to our Deposit Account No. 02-2666.

Respectfully submitted,

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